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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,974	01/05/2000	NADIA TERREN	05725.0490	7391

7590 09/10/2002

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EXAMINER
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BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/10/2002 13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/423,974

Applicant(s)

TERREN ET AL.

Examiner

Alysia Berman

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

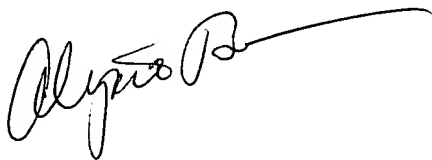
Claim(s) rejected: 75-80, 82-94 and 96-107.

Claim(s) withdrawn from consideration: 108.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☒ Other: See Continuation Sheet

RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200

Continuation of 10. Other: The claims are rejected for reasons of record in the final Office Action mailed May 7, 2002, paper no. 11. Applicant's arguments addressing the 35 U.S.C. 103(a) rejections have been previously addressed in paper no. 11. In response to Applicant's traversal of the withdrawal of claim 108 as being directed to a non-elected invention, the invention of claim 108 was constructively non-elected by original presentation. Applicant has already received an action on the merits for the originally presented invention of a composition, which did not encompass the invention of claim 108 of a method of making a composition. Therefore, withdrawal of claim 108 is proper. Applicant's arguments that the phrase, "an amount effective to provide transfer-resistant properties to the composition" clearly delineates the metes and bounds of the claimed invention is not found persuasive. Neither the specification nor the claims clearly defines the phrase, "transfer-resistant" nor do they disclose an amount or range of amounts effective to provide this transfer resistance. Without such guidance, one of ordinary skill in the art cannot determine the amount needed to provide transfer resistant properties to the composition..

A handwritten signature in black ink, appearing to read "Allyson B.", with a long horizontal flourish extending to the right.